

Remarks

In the final Office Action dated April 21, 2004, the Examiner maintained the rejection of claims 1-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,646,917 to Miyoshi, et al. (hereinafter Miyoshi) in view of U.S. Patent No. 5,486,727 to Heidelberg, et al. (hereinafter Heidelberg). By this paper, Applicants' representative amends independent claims 1, 10 and 17. Support for the amendment to the independent claims can be found, for example, on Figs. 2 and 3, and in the specification on page 8, ll. 16-28. As such, no new matter has been added.

With respect to the Examiner's rejections, the Examiner is invited to consider the following remarks.

Independent claim 1 provides an automated library system that comprises at least one robot that comprises a drive mechanism coupled to drive wheels that ride in at least one rail and rotate to move the robot about within the automated library system. Independent claim 10 provides a robot for use in an automated library system and the robot comprises a frame and a drive mechanism attached to the frame and coupled to drive wheels that ride in at least one rail in the automated library system and rotate to move the robot about within automated library system. Independent claim 17 provides method of operating an automated library system having at least one robot and using a drive mechanism on the robot, wherein the drive mechanism is coupled to drive wheels that ride in at least one rail in the automated library system and rotate to provide the movement of the robot. Miyoshi and Heidelberg, alone or in combination, fail to provide the features of the presently pending invention and the rejection should be withdrawn.

In particular, Miyoshi teaches a horizontal carrier that has a magnet to form a magnetic field passing through a plurality of coils that are sequentially excited to move the carrier in the moving direction. (Miyoshi, Abstract). Miyoshi further teaches a guide rail device is adapted to move the carrier by a magnetic force generated between the guide rail device and the carrier. (Miyoshi, Fig. 5 and col. 3, ll. 64-67). Heidelberg teaches a linear

accelerator that has at least one longitudinal stator section that defines a linear path of movement and that comprises several stator coils as well as a rotor with several rotor coils that can be accelerated along the path of movement. The design and arrangement of the rotor coils and stator coils allow a circular magnetic field to be generated, with the result that the rotor is axially accelerated. (Heidelberg, Abstract). As such, Heidelberg fails to cure the deficiencies of Miyoshi.

Nowhere does any combination of Miyoshi and Heidelberg teach, disclose or suggest the features of the presently pending independent claims. Since the cited references, alone or in combination, fail to teach, disclose or suggest the claimed invention, a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established, and the rejection should be withdrawn.

Furthermore, regarding independent claim 10, that claim provides the secondary coil is electrically connected to an electronics circuit. The electronics circuit is disposed on the frame and is in communication with the drive mechanism and the automated library system to facilitate control of the drive mechanism in accordance with commands from the controller. Neither of the prior art references cited by the Examiner, alone or in combination, teach or suggest a robot comprising an electronic circuit that is in communication with a drive mechanism and an automated library system to facilitate control of the drive mechanism in accordance with commands from a library system controller, as set forth in claim 10.

Regarding claims which depend from independent claims 1, 10 and 17, Applicants contend that these claims are patentable for at least the same reasons that claims 1, 10 and 17 are patentable. Moreover, Applicants contend these claims recite further limitations, in addition to the limitations of claims 1, 10 and 17, which render these claims additionally patentable.

Applicants have made a *bona fide* effort to respond to the Examiner's rejections in advancing the prosecution of this case. Applicants believe all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested.

Please charge this fee plus any additional fees or credit any overpayments as a result of the filing of this paper to Storage Technology Corporation's Deposit Account No. 19-4545 -- a duplicate of this page is enclosed for that purpose.

The Examiner is respectfully requested to telephone the undersigned to discuss prompt resolution of any remaining issues necessary to place this case in condition for allowance.

Respectfully submitted,

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